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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/598,586	06/21/2000	Scott B Heintzeman	8477.99USC1	6546

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EXAMINER

LASTRA, DANIEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/598,586

Applicant(s)

HEINTZEMAN ET AL.

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 41-76 have been examined. 09/598,586 is continuation of 08/892,563. Which is a continuation of 08/439,626, which is a continuation of 08/385,381 (Pat. No. 5,483,444), which is a continuation of 08/143,453 (dated 10/26/1993).

Response to Amendment

2. In response to Final Rejection filed 09/23/2004, the Applicant filed an RCE and an Amendment on 03/25/2005, which amended claims 41 and 61.

Claim Rejections - 35 USC § 112

3. Claims 41-76 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Independent claims 41 and 61 recite an "online purchase of items". The Applicant's specification teaches a system that books travel-related reservations, but does not teach the online purchase of said reservations. Claims 55 and 70 recite "assigning points to the user based upon the monetary value of the on-line purchase". The Applicant's specification does not teach this limitation.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the

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applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 41-76 are rejected under 35 U.S.C. 102(e) as being anticipated by Roach et al (U.S. 5,434,394).

As per claims 41, Roach et al teach:

A computerized on-line incentive system for awarding points to a user conducting an on-line purchase, the system comprising:

(a) an access device connected to a network (see column 5, lines 45-55; figure 1);

(b) a computerized on-line sales environment, connected to the network and thereby accessible to the user of the access device, the on-line sales environment permitting the user to *determine items that are for sale and* conduct an on-line purchase *of said items* (see figure 1, column 5, line 45 – column 7, line 39; column 9, lines 51-61; column 12, lines 25-39). Roach teaches in column 12, lines 24-39 that “a determination is made whether the selected item of merchandise is in stock. If the selected item is not in stock, in step 332 the computer 18 prompts the operator to suggest products comparable to the unavailable merchandise by displaying information on the screen of the computer. In step 334, a determination is made whether the customer desires information concerning products comparable to the unavailable merchandise. If the customers desires information concerning products comparable to the unavailable

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merchandise, the computer 18 in step 336 displays comparable product information". Therefore, Roach system advises a user whether items desired to be purchased are available for purchase prior to purchase, and if said items are not available, Roach provides said user with alternative items (see column 13, lines 45-50).

(c) an on-line award system connected to the network, the on-line award system being in communication with the on-line sales environment and possessing an account holding a point total corresponding to the user (see column 7, lines 1-39; column 9, lines 51-63; column 10, lines 35-67; column 11, line 44 – column 12, line 15; column 13, lines 1-30).

As per claim 61, Roach teaches:

A computerized on-line method for awarding points to an individual conducting an on-line purchase, comprising steps of:

a) receiving on-line purchase information from a user via an access device connected to a network (see column 10, lines 1-35);

b) *determining availability of item to be purchased* (see column 12, lines 21-38);

c) communicating the on-line purchase information to an awards system following the purchase of said item (see column 7, lines 1-39; column 9, lines 51-63; column 10, lines 35-67; column 11, line 44 – column 12, line 15; column 13, lines 1-30).

d) awarding points to the user based on the on-line purchase information (see column 19, lines 15-30); and

e) cumulating the points in a specified account for the user (see column 19, lines 15-30).

As per claim 42, Roach et al teach:

The computerized on-line incentive system of claim 41, wherein the computerized on-line sales environment comprises:

- (a) a computerized reception component adapted to receive information relating to the on-line purchase (see column 4, lines 24-46; column 5, lines 45-55);
- (b) a computerized processing component adapted to process the information relating to the on-line purchase (see column 4, lines 24-46); and
- (c) a computerized purchasing component adapted to effectuate the on-line purchase (see column 10, lines 36-67).

As per claim 43, Roach et al teach:

The computerized on-line sales environment of claim 42, wherein the reception component, processing component, and purchasing component reside on two or more computers that are in communication with each other and the network (see figure 1, 6).

As per claim 44, Roach et al teach:

The computerized on-line incentive system of claim 41, wherein the computerized on-line sales environment comprises:

- (a) a computerized on-line purchase system adapted to receive the on-line purchase request (see columns 5-6);
- (b) a conversion system adapted to convert the on-line purchase request into one or more different formats (see column 10, line 36 – column 12, line 15); and
- (c) an on-line purchase facility adapted to effectuate the on-line purchase (see column 10, line 36 – column 12, line 15).

As per claim 45, Roach et al teach:

The computerized on-line incentive system of claim 41, wherein the computerized on-line sales environment comprises one or more on-line purchase computers connected to the network, the on-line purchase computers being adapted to receive, process, and effectuate the online purchase request (see columns 10-12).

As per claims 46 and 62, Roach et al teach:

The computerized on-line incentive system of claim 41, wherein the on-line award system further comprises a verifier classifying a point amount as pending until a predetermined event occurs and converting the pending point amount to a redeemable point amount after the occurrence of the event (see column 13, lines 10-30).

As per claims 47 and 63, Roach et al teach:

The computerized on-line incentive system of claim 41, wherein the on-line award system further comprises a verifier classifying a point amount as pending for a predetermined amount of time after the assignment of the point amount and converting the pending point amount to a redeemable point amount after the predetermined amount of time (see columns 13-14).

As per claims 48 and 64, Roach et al teach:

The computerized on-line incentive system of claim 41, wherein the on-line award system further comprises:

(a) a first verifier classifying a point amount as pending until a predetermined event occurs (see column 13); and

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(b) a second verifier maintaining the point amount as pending for a predetermined amount of time after the occurrence of the event and converting the pending point amount to redeemable after the predetermined amount of time (see columns 13-14).

As per claim 49, Roach et al teach:

The computerized on-line incentive system of claim 42, wherein the information relating to the on-line purchase includes a log-in identifier related to the user (see column 11, lines 11-18).

As per claims 50 and 65, Roach et al teach:

The computerized on-line incentive system of claim 41, wherein the on-line awards system further comprises a reporter adapted to report the point total assigned to the user (see figures 4a, 4b).

As per claims 51 and 66, Roach et al teach:

The computerized on-line incentive system of claim 50, wherein the reporter reports on-line the point total to the user (see figures 4a, 4b).

As per claims 52 and 67, Roach et al teach:

The computerized on-line incentive system of claim 50, wherein the reporter reports in a hard copy format the point total for the user (see figure 4e).

As per claims 53 and 68, Roach et al teach:

The computerized on-line incentive system of claim 50, wherein the reporter reports a pending point total for the user (see column 13, lines 10-30).

As per claims 54 and 69, Roach et al teach:

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The computerized on-line incentive system of claim 50, wherein the reporter reports a redeemable point total for the user (see column 13, lines 10-30).

As per claims 55 and 70, Roach et al teach:

The computerized on-line incentive system of claim 41, wherein the on-line awards system awards a point amount to the user's account based on the monetary value of the on-line purchase (see column 10, line 36 – column 11, line 4).

As per claims 56 and 71, Roach et al teach:

The computerized on-line incentive system of claim 41, wherein the on-line awards system identifies on-line whether the user has previously received points (see column 9, lines 50-62; column 13, lines 10-30).

As per claims 57 and 72, Roach et al teach:

The computerized on-line incentive system of claim 41, wherein the on-line awards system assigns a bonus point amount to the user based upon a predetermined activity in conjunction with the on-line purchase (see column 13, lines 10-30).

As per claims 58 and 73, Roach et al teach:

The computerized on-line incentive system of claim 57, wherein the on-line award system assigns the bonus point amount to the user based upon one or more given criteria (see column 13).

As per claims 59 and 74, Roach et al teach:

The computerized on-line incentive system of claim 42, wherein the information relating to the on-line purchase uniquely identifies the user (see column 7, lines 11-38).

As per claims 60 and 75, Roach et al teach:

The computerized on-line incentive system of claim 41, wherein the on-line awards system modifies the user's point total in response to adjustment or cancellation of the online purchase (see column 11, lines 5-19).

Response to Arguments

5. Applicant's arguments filed 25 march 2005 have been fully considered but they are not persuasive. The Applicant argues that claim 41 has been amended to specifically set forth that the on-line sales environment permits the user to determine items that are for sale and conduct an on-line purchase of the items and that this concepts is adverse to Roach because in Roach, items being purchased are in the warehouse and available. The Applicant further argues that in his claimed invention the system advises the user whether items desired to be purchased are available for purchase prior to purchase and that this is contrary to the Roach patent.

The Examiner answers that claim 41 teaches "the on-line sales environment permitting the user to determine items that are for sale and conduct an on-line purchase of said items" and claim 61 recites "a) receiving on-line purchase information from a user via an access device connected to a network b) determining availability of item to be purchased". Roach teaches in column 12, lines 24-39 that "a determination is made whether the selected item of merchandise is in stock. If the selected item is not in stock, in step 332 the computer 18 prompts the operator to suggest products comparable to the unavailable merchandise by displaying information on the screen of the computer. In step 334, a determination is made whether the customer desires information concerning products comparable to the unavailable merchandise. If the customers desires

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information concerning products comparable to the unavailable merchandise, the computer 18 in step 336 displays comparable product information". Therefore, Roach system advises a user whether items desired to be purchased are available for purchase prior to purchase, and if said items are not available, Roach provides said user with alternative items (see column 13, lines 45-50). Therefore, Roach teaches the Applicant's claimed invention.

The Applicant argues that Roach does not teach an online system. The Examiner answers that Moore teaches client computers (i.e pen based computers) connected to remote computers or servers via line 60 leased by Compuserve (see figure 1, in column 3, line 35 – column 4, line 6). Therefore, Roach teaches an online system, similar to Applicant's claimed invention.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 571-272-6724. The right fax number for the Examiner is 571-273-6720.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Lastra *DL*

May 14, 2005


RAQUEL ALVAREZ
PRIMARY EXAMINER